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09/900,787	07/06/2001	Matthew Levine	MLE-10502/29	7680

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EXAMINER

LIANG, LEONARD S

ART UNIT PAPER NUMBER

2853

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/900,787
Filing Date: July 06, 2001
Appellant(s): LEVINE, MATTHEW

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/31/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-8 and 10 and claims 11-14 and 16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,978,000	Levine	11-1999
4,836,742	Ishiguro et al.	6-1989
4,025,838	Watanabe	5-1977

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 and 11-14 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 6.

Claims 10 and 16 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 6.

(11) Response to Argument

The appellant argues, "Claim 1, a method claim, includes the steps of 'providing a surface including options relating to the programming of the instrument.' With respect to this limitation, the Examiner refers to Figure 1, reference numerals 102, 106, and 110, which are simply the chart itself with intersecting lines printed thereon. These have nothing to do with the programming of the instrument, but rather, something at the instrument, once programmed, overwrites." The examiner refers applicant to column 2, lines 49-53 where it is clearly disclosed that lines 106 and 110 are not just chart-forming grid lines, but are lines **indicative of a measured quantity, such as pressure, temperature, humidity, etc.** Thus, these references are highly related to the programming of the instrument.

The appellant further argues, "Claim 1 additionally includes the limitation of 'storing information relating to the location of surface positions accessible by the marking implement.' To address this limitation, the Examiner points to Figure 2, and the specification at column 3, lines 41-65. However, Figure 2 is a block diagram, and column 3, lines 41-65 discusses the hardware. Pointing to particular structural elements, even if they could perform a particular function, falls short of anticipating a method step." The examiner responds by noting that not

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only is the method step naturally suggested by Figure 2, but column 3, line 48-50 **explicitly states** the method step of containing set point data in memory.

The appellant further argues “Claim 1 further includes a limitation of ‘moving at least a marking implement relative to the visual options for selection purposes.’ Again, the Examiner points to certain hardware which, presumably, the Examiner assumes could perform the stated function, also citing column 2, lines 60-67 which discuss the way in which according to the ‘000 patent, an operator may move a pen to write set points onto the chart paper. Thus, a marking implement is not moved relative to visible options for selection purposes, since the visual options are not yet there.” The examiner responds by noting that the visual options in questions are not deemed to be just set points, they are lines 106 and 110, which as shown above, are indicative of a measured quantity. Thus, the act of setting set points on the lines 106 and 110 is equivalent to moving a marking implement relative to the visible options (lines 106 and 110).

The appellant further argues ‘claim 1 includes the limitation of ‘programming the instrument by correlating the position of the implement during the movement thereof to determine the options selected.’ Here, the Examiner points to column 1, lines 55-67 which discusses only the fact that set points may be programmed into a chart recorder and made visible on the chart recorder paper. Again, this has nothing to do with selecting existing options, but rather, involves a technique whereby predetermined set points are made visible.” In response, the examiner submits that the appellant may be confused by what qualifies as “visible options”. As noted above, lines 106 and 110 represent “visible options” and the act of setting set points is equivalent to “selecting” options; options can be seen to be highly dependent upon position.

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The appellant further argues "Claim 11 is similar in scope to claim 1, but includes the limitation of 'moving at least the pen relative to the printed parameters so as to select certain of the parameters by marking the chart with the pen.' There are no 'printed parameters' included in the '000 patent which would be applicable to this claim." As discussed above, lines 106 and 110 are "printed parameters" which are very applicable to the claim since a pen is marked relative to these lines so as to set a set point by marking these parameters.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

lsl 152
June 16, 2003

The conference was held 06/11/03.

Conferees

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